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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,233	03/10/2004	Dan W. Dansie		2958
7590	09/14/2005		EXAMINER	
Dan Dansie 380 West Utah Ave. Payson, UT 84651			GIBSON, KESHIA L	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/797,233	DANSIE, DAN W.
	Examiner Keshia Gibson	Art Unit 3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/10/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to an apparatus for use during oral surgery, classified in class 604, subclass 1.
  - II. Claims 11-12, drawn to a method of making an apparatus for use during oral surgery, classified in class 604, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product could be made by wrapping floss around a piece of gauze, or by stamping out a piece of foam then melting a thermoplastic piece of string to it.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Gordon Hill on 9/7/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 11-12 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reimels (US 3,736,935).

In regard to Claims 1-3 and 7-9, Reimels discloses an apparatus for use during oral surgery 10 comprising a nonwoven, rayon gauze having a nylon string attached to it (column 2, line 5-47). Reimels does not expressly disclose that the string is at least 14 inches long. However, Reimels discloses that the string serves to insure that the absorbent pad is retrieved from the wound site and that the length is not critical as long

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as it is long enough to be placed a sufficient distance outside of the wound site. As such, the length of the string is considered to be a result effective variable. Thus, it would have been obvious to one of ordinary skill in the art to provide the string with a length of at least 14 inches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reimels in view of Valentine (US 5,387,206).

In regard to Claim 4, Reimels discloses the claimed invention but does not expressly teach that the sponge further comprises a second string. However, it would have been obvious to one of ordinary skill in the art to provide the surgical sponge of Reimels with a second string since one withdrawal string and two withdrawal strings are art recognized equivalents for their use as removing an absorbent, such as a surgical sponge, from a body cavity, as supported by Valentine et al. (US 5,387,206; Figs. 1 and 2) and the selection of any of these known equivalents to retrieve a surgical sponge from a body cavity would be within the level of ordinary skill in the art.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reimels in view of Johnson (US 3,863,636).

In regard to Claim 5, Reimels discloses the claimed invention but does not expressly teach that the sponge string is colored. However, it is known in the art to color elements

of an absorbent article for contrast so to be easily detected by a user, as supported by Johnson (US 3,863,636; column 4, lines 66-68). Thus, it would have been obvious to one of ordinary skill in the art to provide the sponge of Reimels with a colored string since it was known in the art color elements of an absorbent article for identification and detection purposes.

10. Claims 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reimels in view of Fabian (US 2005/0049564).

In regard to Claims 6 and 10, Reimels does not expressly disclose that the sponge is sterilized. However, it is known to sterilize medical instruments and materials to reduce the chance of contamination of a wound or other treated site, as supported by Fabian US 2005/0049564 ([0036]). Thus, it would have been obvious to one of ordinary skill in the art to sterilize the sponge of Reimels since it was known in the art to sterilize sponges and other medical devices.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Storey, Jr. et al. (US 5,033,462), Riordan (US 2,007,503), Shippert (US 6,517,509), and Cokeley (US 5,030,092).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keshia Gibson whose telephone number is (571) 272-

7136. The examiner can normally be reached on M-F 8:30 a.m. - 6 p.m., out every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Keshia Gibson  
Examiner  
Art Unit 3761

kig 9/8/05

TATYANA ZALUKAEVA  
PRIMARY EXAMINER

